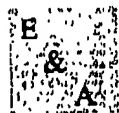


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GROUP 1600



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OFFICIAL

## FACSIMILE TRANSMITTAL

DATE: January 6, 2003

TO: U.S. Patent & Trademark Office  
Examining Group 1600

FAX NO.: 1-703-872-9306

FROM: John B. Alexander, Ph.D.

FAX NO.: 617-439-4170

Our Docket No.: 48460 (70157)

No. of Pages (incl. cover): 8

Re: U.S. Serial Number 09/890,112

## MESSAGE:

Please enter the attached Amendment.

## NOTICE

The message and/or information which accompanies this facsimile cover sheet is intended for the addressee named above only. If you are not the intended recipient, please contact the sender by collect telephone at the number indicated. You will be advised regarding the disposition of what you have received. The mis-delivery of the message and/or information which accompanies this facsimile cover sheet is not intended to be and shall not constitute a disclosure of trade secrets, of attorney work product or of an attorney-client communication. No waiver of any privilege is intended. Thank you for your attention to this matter.

BOSTON HARTFORD NEWPORT NEW YORK PALM BEACH PROVIDENCE SHORT HILLS

Docket No. 48460 (70157)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: A. Rosowsky

Serial No.: 09/890,112

Examiner: T. McKenzie

Filed: July 26, 2001

Group Art Unit: 1624

For: PHARMACEUTICALLY ACTIVE COMPOUNDS AND METHODS OF USE  
THEREOFAssistant Commissioner for Patents  
Washington, D.C. 20231**AMENDMENT TRANSMITTAL**

1. Transmitted herewith is a Response to the Restriction Requirement for this application.

**STATUS**

2. Applicant is  
[X] a small entity. A statement:  
[ ] is attached.  
[ ] was already filed.  
[ ] other than a small entity.

---

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8(a))**

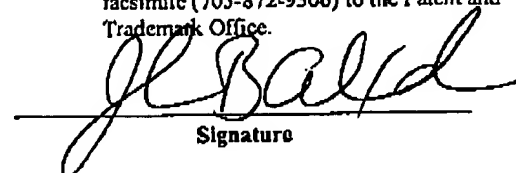
I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

- ☐ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

**FACSIMILE**

- ☒ transmitted to Technology Center 1600 by facsimile (703-872-9306) to the Patent and Trademark Office.

  
Signature

Date: January 6, 2003

John B. Alexander, Ph. D.  
(type or print name of person certifying)

(Amendment Transmittal—page 1 of 4)

**EXTENSION OF TERM**

**NOTE:** "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

**NOTE:** See 37 C.F.R. § 1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 380.00	\$ 190.00
<input type="checkbox"/>	three months	\$ 890.00	\$ 445.00
<input type="checkbox"/>	four months	\$ 1,360.00	\$ 680.00

Fee: \$ \_\_\_\_\_

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

**OR**

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

(Amendment Transmittal—page 2 of 4)

**FEE FOR CLAIMS**

4. The fee for claims (37 C.F.R. § 1.16(b)-(d)) has been calculated as shown below:

					OTHER THAN A SMALL ENTITY			
(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY					
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	OR	Rate	Addit. Fee	
Total	Minus	20	=	x \$9 = \$0		x \$18 =	\$	
Indep.	Minus	3	=	x \$39 = \$0		x \$78 =	\$	
[ ] First Presentation of Multiple Dependent Claim				+ \$130 = \$0		+ \$260 =	\$	
				Total Addit. Fee	OR	Total Addit. Fee		
				\$ 0.00				

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3.  
 \*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
 \*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
 The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** "After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. § 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

- (c) [X] No additional fee for claims is required.

OR

- (d) [ ] Total additional fee for claims required \$ \_\_\_\_\_

**FEE PAYMENT**

5. [ ] Attached is a check in the sum of \$ \_\_\_\_\_.  
 [ ] Charge Account No. \_\_\_\_\_ the sum of \$ \_\_\_\_\_.  
 A duplicate of this transmittal is attached.

(Amendment Transmittal—page 3 of 4)

**FEE DEFICIENCY**

**NOTE:** *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

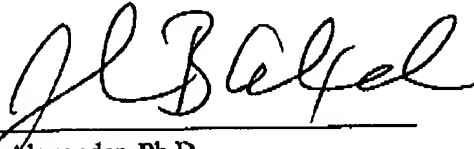
6. ☒ If any additional extension and/or fee is required, charge Account No. 04-1105  
**AND/OR**

☒ If any additional fee for claims is required, charge Account No. 04-1105

Respectively submitted,

January 6, 2003

By:

  
John B. Alexander, Ph.D.  
Reg. No. 48,399

Dike, Bronstein, Roberts & Cushman  
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323145\_1



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PATENT TRADEMARK OFFICE

(Amendment Transmittal—page 4 of 4)

#7

Docket No. 48460 (70157)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: A Rosowsky  
SERIAL NO: 09/890,112 EXAMINER: T. McKenzie  
FILED: July 26, 2001 GROUP: 1624  
FOR: PHARMACEUTICALLY ACTIVE COMPOUNDS AND METHODS OF USE  
THEREOF

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

.....  
**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to Group 1600 of the U.S. Patent & Trademark Office by facsimile number 703-872-9306 on January 6, 2003.

By: 

John B. Alexander, Ph.D.

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

Applicants are in receipt of the Office Action dated December 5, 2002 in connection with the above-identified application. Kindly amend the application as follows:

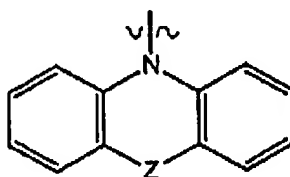
**REMARKS**

Applicants respectfully traverse the restriction requirement.

Applicants believe that the restriction set forth by the Examiner fails to classify several of the groups of compounds provided by the independent claims. In particular, compounds of claim 1 in which X is nitrogen and Z is optionally substituted ethylene (e.g., compounds comprising a dihydrodibenzoazepine group) or optionally substituted azamethylene (e.g., compounds comprising a dihydrodibenzodiazepine group) do not appear to be included in any of the Groups set forth in the Restriction Requirement.

A. Rosowsky  
U.S.S.N.: 09/890,112  
Page 2

It is believed that multiple groups could be searched and examined together without undue burden. For instance, compounds of Groups II-VII and compounds having a dihydrodibenzoazepine or dihydrodibenzodiazepine group share a common core structure, e.g., a diphenylamino group having a linker group between the phenyl rings. More particularly, these compounds comprise a group of the structure:



where Z is O, S, optionally substituted nitrogen, optionally substituted methylene, optionally substituted ethylene ( $-\text{CH}_2\text{CH}_2-$ ), optionally substituted vinyl ( $-\text{CH}=\text{CH}-$ ), optionally substituted azamethinyl ( $-\text{N}=\text{CH}-$ ), or optionally substituted azamethenyl ( $-\text{NHCH}_2-$ ).

As such, the compounds in Groups II-VII and compounds having a dihydrodibenzoazepine or dihydrodibenzodiazepine group possess a common ring structure which can be effectively searched using a substructure search query in one or more standard electronic chemical databases. Applicants believe that searching these additional groups of compounds will not pose an additional burden on the Examiner and request the combined examination of Groups II-VII.

Applicants further request that the Examiner search, in combination with compounds of Groups II-VII, compounds of Groups VIII-XII in which X is carbon. Applicants believe that the complexity of a prior art search to be carried out by the Examiner will not increase significantly from the consideration of compounds of Groups II-VII to consideration of compounds of groups II-XII. Moreover, Applicants believe that the inclusion of compounds having X = carbon can be incorporated into the same substructure search queries required for the search of one or more of Groups II-VII. Thus the combination of Groups II-XII will not place an undue burden upon the Examiner to search the related art.

A. Rosowsky  
U.S.S.N.: 09/890,112  
Page 3

Reconsideration of the Restriction is earnestly solicited.

Nonetheless, to provide a complete response, Applicants provisionally elect Group III, drawn to compounds comprising a dibenzazepine groups. In the absence of rejoinder of Groups II-XII, or alternatively Groups II and IV-VII, with Group III, Applicants request that compounds comprising a dihydrobenzazepine group, which were not included in any of the Groups defined by the Examiner, be incorporated into Group III.

This election is being made solely to comply with the Restriction Requirement and the right to file divisional applications on non-elected subject matter is reserved.


Alternately, Applicant request that rejoinder of some, if not all, of the remaining groups be considered by the Examiner following the search of the elected group (Group III).

Early consideration and allowance of the application are earnestly solicited.

January 6, 2003



Respectfully submitted,

  
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